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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,077	09/12/2003	Eldon L. Decker	1887A1	9797

7590 07/01/2004

PPG INDUSTRIES, INC.  
Intellectual Property Department  
One PPG Place  
Pittsburgh, PA 15272

EXAMINER
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AHMED, SHEEBA

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

JK

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/662,077		DECKER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Sheeba Ahmed		1773	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/11/04</u> . | 6) <input type="checkbox"/> Other: ____  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Bawa (US 4,702,574).

Bawa discloses contact lenses that are colored with fluorescent colorants (Column 1, lines 8-10) wherein the fluorescent dye or pigment fluoresces in daylight (Column 2, lines 32-34 and 39-41) and wherein another portion of the contact lens contains a white reflective pigments such as titanium oxide. The florescent colorants used in the lenses may be pigments or dyes and are capable of fluorescing in a carrier resin (Column 3, lines 49-55), i.e., they reflect at certain wavelength of visible light (Column 4, lines 1-6). Examples include coumarins and phthalocyanine dyes (Column 4, lines 35-50). The colorant is mixed in a polymer at a range of about 0.2 to 8 weight percent (Column 6, lines 38-40 and 46-51) and may have a particle size in the range of 0.175 to 20 nm (Column 7, lines 1-5). With regards to the limitations that the color value  $L^*$  of the second layer is less than about 40, the Examiner takes the position that such a property limitation must be inherently met by the contact lenses taught by Bawa given that the composition and amount of the colorants and reflective pigments as taught by

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Bawa and that of the claimed invention are identical. All limitations of claims 1-17 are disclosed in the above reference.

2. Claims 1, 2, 10-13, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayes et al. (US 4,472,479).

Hayes et al. disclose fluorescent printing ribbons, which have a reflective pigment therein (Column 1, lines 11-15). To prepare the ribbon, layer of wax or other suitable medium and fluorescent material is deposited on the ribbon base, which may be a thin film of plastic, and a reflective barrier material is added to this layer or deposited in a second layer of wax upon the first layer. The barrier pigments used are pigments of finely divided metals or materials with metallic colors which are reflective and do not shift the wavelength of the fluorescent light (Column 2, lines 1-4). The pigments are finely divided pigments of reflective material which do not shift the wavelength of fluorescent light and examples include mica platelets coated with titanium oxide. The fluorescent material is a mixture of fluorescent dyes suspended in a polyester resin (Column 3, lines 40-55). With regards to the limitations that the color value  $L^*$  of the second layer is less than about 40, the Examiner takes the position that such a property limitation must be inherently met by the contact lenses taught by Bawa given that the composition and amount of the colorants and reflective pigments as taught by Bawa and that of the claimed invention are identical. All limitations of claims 1, 2, 10-13, 16, and 17 are disclosed in the above reference.

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**Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-4, 7, 8, and 9-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13 and 14 of copending Application No. 10/661,964. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claims a coated substrate comprising an upper layer of a binder and fluorescent colorants and a lower layer of a binder and light absorbing particles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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**Conclusion**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Monday-Friday from 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (571)272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sheeba Ahmed

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June 28, 2004